



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,632	03/28/2001	Kenji Morita	041465-5102	1731
9629	7590	01/24/2005	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EDWARDS, PATRICK L	
			ART UNIT	PAPER NUMBER
			2621	

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,632

Applicant(s)

MORITA ET AL.

Examiner

Patrick L Edwards

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The response received on July 23, 2004 has been placed in the file and was considered by the examiner. An action on the merits follows.

Response to Arguments

2. The applicant's arguments, filed on July 23, 2004, have been fully considered. A response to these arguments is provided below.

Specification Objections

Summary of Argument: In the previous office action, the specification was objected to because of spelling and grammatical errors. Applicant has amended the specification accordingly, and argues that the previous objection should now be withdrawn.

Examiner's Response: The amendments to the specification have been received and are greatly appreciated. The prior objection is hereby withdrawn.

Prior Art Rejections

Summary of Argument: In the previous office action, claims 1, 2, 5, and 6 were rejected under 35 USC § 102b as being anticipated by Okunoki. Applicant traverses the rejection to independent claims 1 and 5, and argues that the Okunoki reference fails to disclose, teach, or suggest that "each element static image information, which make up the moving image information of the instant application, when stored in the image information storage device, contains has [sic] less information than each of the static image information." (applicant's remarks, pg. 10). More specifically, applicant argues that a frame of the moving foreground image would undoubtedly include a higher density of information than each background image (remarks pg. 10)

Examiner's Response: Applicant's arguments have been fully considered, but are not persuasive. Okunoki discloses a foreground image and a background image. Applicant's characterization of the Okunoki background image as 'simple background information which consists of a single color, or a simple design' is taken out of context. Okunoki discloses a *temporary background* formed of a single color, which is replaced by a desired background picture (Okunoki col. 3 lines 45-47). This desired background picture data is stored in frame buffer 66, and consists of RGB data. The foreground data of Okunoki also consists of RGB data. Thus, applicant's assertion that the foreground image contains a higher density of information is simply incorrect. The only way that the foreground image would contain a higher density of information than the background image is if a) it had a higher resolution (more dots per inch) than the background image or b) if the rgb values of the background image were represented by fewer bits than the rgb values of the foreground image. Neither of these two conditions, however, holds true in the Okunoki disclosure. Referring to part (a), Okunoki discloses vertical and horizontal

Art Unit: 2621

synchronization between data reading from the frame buffers that hold the moving image and the background image, respectively. Furthermore, the composite image is sent to a monitor for the displaying of the image. So there simply can't be a disparity in resolution. Thus, we can conclude that the composite image has a uniform resolution throughout. Referring to part (b), Okunoki discloses that the only difference between the foreground image data and the background image data is that the foreground image data has a priority bit with a value of '1', while the background image data has a priority bit with a value of '0'. Both foreground and background images are in the RGB format. They are stored in separate frame buffers, and the graphics processor establishes vertical and horizontal synchronization between the data reading from the two buffers. Thus, we can conclude that each pixel in the composite image is defined by the same number of bits. This is conventional in the art and is to be expected.

In light of the above discussion, the examiner asserts that the applicant's argument that the foreground image contains a higher density of information has no basis in fact, and are simply incorrect. As a result, applicant's statement that "the fact that the moving image might occupy a smaller area on the display screen does not mean that it includes less information than the background image" is incorrect for the same reasons. It follows that the background image, which clearly occupies a larger area than the foreground image, contains more information than the foreground image.

However, even if we ignore the above argument and assume, *arguendo*, that the foreground image does have a higher density than the background image, this would not preclude the Okunoki reference from anticipating the claims in question. Indeed, the claim does not require that the background image occupy more memory space than the foreground image. It simply requires the background image to have a greater amount of image information than the foreground image. Therefore, even if we ignored the above argument, Okunoki would still anticipate this limitation, because it shows the background occupying a greater area than the foreground. Without any guidance as to what we are supposed to use to quantify the 'amount of image information', it is reasonable to use physical space as our barometer.

In view of the above arguments, we can confidently conclude that Okunoki anticipates the claims in question, regardless of interpretation.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 9 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Art Unit: 2621

Both of these claims recite that the static image information and the moving image information are sequentially displayed. The specification does not contain support for these added limitations. First of all, the specification fails to mention anything about sequentially displaying the static and moving images. In fact, the words 'sequential' or 'sequentially' are completely absent from the specification. Secondly, there are several instances in the specification where it is stated that "the static and moving images are displayed as if they were an [sic] continual animation". This statement indicates simultaneous display of the moving and static images. Also, a statement such as 'the static and moving images ... are displayed as if they were connected' gives the exact same impression.

Applicant states that Figures 6a-d illustrate an example of this sequential display. These figures are described in the applicant's specification at paragraphs [0082-0084]. The examiner has closely read this passage in conjunction with the Figures, but is not persuaded that this provides support the claimed limitation. Figures 6b and 6c allegedly show a moving image. But the alleged static images shown in Figures 6a and 6d are included in both of the alleged moving images. As a result it appears as if these Figures are merely showing the frames of a moving image at different stages in time. It is well known in the art that a moving image consists of a plurality of still images. Therefore every moving image has a beginning frame and an ending frame. It appears as if Figure 6a is merely showing the first frame of a moving image (which is inherently a still image), Figures 6b and 6c show two frames which illustrate that the image is moving, and then Figure 6d merely shows the last frame of a moving image (which is inherently a still image). As a result, the combination of Figures 6a-d and paragraphs [0082-0084] provide insufficient support for the claim that static images and moving images are sequentially displayed. The rest of the applicant's disclosure appears to provide support for this conclusion. It makes a clear distinction between 'static images' and the 'element static images' which form a moving image. Since Figure 6 shows that a moving image contains a still image, we can either conclude that a) the still images shown in Figure 6 are the 'element static images' which make up a moving image, or b) that the static images and the element static images are one in the same. Neither of these conclusions is in accord with the limitations recited in newly added claims 9 and 11.

It does not appear that the disclosure contains proper support for the limitations of newly added claims 9 and 11. Thus, these claims contain new matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2621

6. Claims 1, 2, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Okunoki et al. (USPN 5,808,682).

With regard to claim 1, which is representative of claim 5, Chida discloses an image information storing device for storing a plurality of static image information and a plurality of moving image information (col 7 line 15 – col 8 line 24). The combination of the frame buffers 165 and 166 disclosed in Okunoki is analogous to image information storing device as recited in the claim in that the frame buffer 165 contains moving image information and the frame buffer 166 contains static image information. The moving picture data disclosed in Okunoki is analogous to the moving image information recited in the claim. The background picture disclosed in Okunoki is analogous to the static image information recited in the claim.

Okunoki further discloses that the moving picture data comprises frames of data (col 7 lines 15-23), which are analogous to the element static image information (or the static image data which form a moving image) as recited in the claim.

Okunoki further discloses that each of the element static image information is smaller than the static image information (Figure 8a). The foreground picture 31 disclosed in Okunoki is the moving image information and the background picture 30 is the static image information. Figure 8a of Okunoki clearly shows the moving image information to be smaller than the static background information.

Okunoki further discloses an image processing device for reading the static image information and the moving image information from the image information storing device to perform image processing and generate processing information to be displayed (col 8 lines 6-54 in conjunction with Figure 7).

With regard to claim 2, which is representative of claim 6, Okunoki further discloses enlarging the element static image information (col 9 lines 36-40).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okunoki as applied to claims 1 and 5 above, and further in view of Okada (5,729,295). The arguments as to the relevance of Okunoki as applied in paragraph 3 above are incorporated herein.

With regard to claim 3, which is representative of claim 7, Okunoki further discloses enlarging the moving image information without enlarging the static information (Okunoki col 9 lines 15-30), but does not expressly disclose a device for determining whether the static image information is being read or the moving image

Art Unit: 2621

information is being read. Okada, however, discloses a device for determining whether or not the image information being read is static or moving (Okada col 3 lines 12-19). The background area disclosed in Okada is analogous to the static image information as recited in the claim.

It would have been obvious to one reasonably skilled in the art at the time of the invention to modify Okunoki's image processing apparatus by including a determining device that determines whether or not the image information being read is static image information or moving image information as taught by Okada. Such a modification would have allowed for a system that could differentiate between the two types of image information and avoid any misprocessing of the image information.

9. Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okunoki as applied to claims 1 and 5 above, and further in view of Takeuchi (USPN 5,990,860). The arguments as to the relevance of Okunoki as applied in paragraph 3 above are incorporated herein.

With regard to claim 4, which is representative of claim 8, Okunoki fails to expressly disclose that the static image corresponding to the static image information is a static image used for selecting functions in an image processing apparatus. Takeuchi, however, discloses an image processing apparatus in which still images are used for selecting different functions (Takeuchi col 11 lines 33-39). It would have been obvious to one reasonably skilled in the art at the time of the invention to modify Okunoki's image processing apparatus by including the use of the static image information to select image processing functions as taught by Takeuchi. Such a modification would have allowed for an interactive multimedia system in which a still image displayed on a monitor could be used to select image processing functions. This would have increased user operability of the system.

With regard to second limitation of the claim, Takeuchi further recites that the moving image corresponding to the moving image information is displayed while one static image corresponding to one static image information is being changed to another static image corresponding to another static image information (Takeuchi col 13 line 58 – col 14 line 15 in conjunction with Figure 10). The left side window shown in Figures 10a-b shows one static image corresponding to one static image information being changed to another static image corresponding to another static image information. It would have been obvious to one reasonably skilled in the art at the time of the invention to modify Okunoki's image processing apparatus by including the simultaneous display of the moving image information and the changing of the static image information. Such a modification would have allowed for a more interactive system in which moving pictures could be displayed while static images changed according to static image information.

10. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okunoki as applied to claims 1 and 5 above, and further in view of Crosby (USPN 5,223, 493). The arguments as to the relevance of Okunoki as applied above are incorporated herein.

Art Unit: 2621

Claims 9 and 11 call for the performance of image processing so that the static images and the moving images are sequentially displayed. The Okunoki reference fails to expressly disclose this additional limitation. Crosby, however, performs image processing such that the static images and the moving images are sequentially displayed (Crosby col. 11 lines 26-37). It would have been obvious to one reasonably skilled in the art at the time of the invention to modify Okunoki's image processing apparatus by performing processing that allows the static images and the moving images to be sequentially displayed. Such a modification would have added a different element to the system which would have resulted in a more powerful display technique capable of complex imaging at visually acceptable display speeds (Crosby col. 2 lines 25-27).

11. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okunoki as applied to claims 1 and 5 above, and further in view of Chase et al. (USPN 6,529,214). The arguments as to the relevance of Okunoki as applied above are incorporated herein.

Referring to claims 10 and 12, Okunoki fails to expressly disclose performing image processing so that the size of a static image becomes equivalent to the size of a moving image (i.e. 'element static image'). The Chase reference, however, discloses displaying a graphics image with a background image such that the background image is sized to be displayed as the same size as the graphics image (Chase col. 2 lines 40-44). The 'sizing' of the background image disclosed in Chase is a form of image processing. It would have been obvious to one reasonably skilled in the art at the time of the invention to modify Okunoki's image processing apparatus by performing processing so that the foreground and background images become the same size as taught by Chase. Such a modification would have allowed for a way of equating the sizes of the two images so that they can be displayed together in a given display area (Chase col. 2 lines 40-49).

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2621

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick L Edwards whose telephone number is (703) 305-6301. The examiner can normally be reached on 8:30am - 5:00pm M-F.

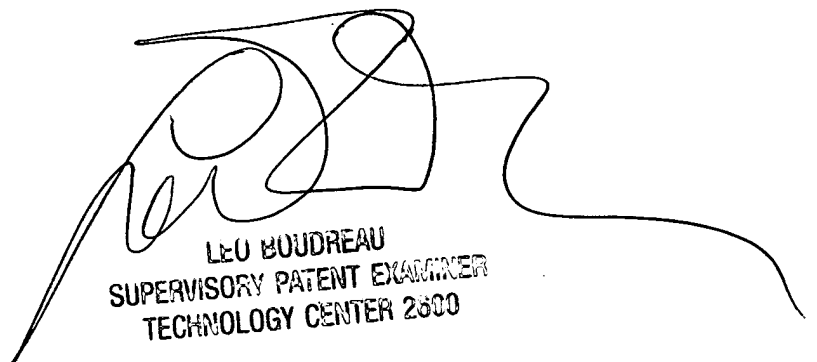
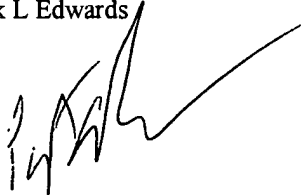
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau can be reached on (703) 305-4706. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patrick L Edwards

Art Unit 2621

ple



LEO BOUDREAU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600